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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,238	09/27/2001	Rongdian Fu	55525-8049.US00	6602

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EXAMINER

GUNTER, DAVID R

ART UNIT PAPER NUMBER

1634

DATE MAILED: 12/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/967,238

Applicant(s)

FU ET AL.

Examiner

David R. Gunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Restriction Requirement***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 and 26-28, drawn to a method of determining relative abundance of a nucleic acid sequence, classified in class 435, subclass 6.
- II. Claims 18-23, drawn to a kit for use in determining the relative abundance of nucleic acid sequences, classified in class 536, subclass 22.1.
- III. Claims 24-25, drawn to a kit for use in preparation of tagged probes, classified in class 536, subclass 22.1.

1. Groups I and II are related as product and process of use. The groups can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the kit of group II comprises a reference nucleic acid library and a plurality of probes that are derived from two different sources and that have appended to them a terminal sample ID sequence. The library and probes can be used in a plurality of materially different processes than the method of group I, including the identification of DNA binding proteins. Because these inventions are related for the reasons given above and the search required for Group I is not coextensive with the search required for Group II, restriction for examination purposes as indicated is proper.

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2. Groups I and III are related as product and process of use. The groups can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case, the kit of group III comprises two or more adapters comprising (i) a protruding single strand, (ii) a sample ID sequence, (iii) a restriction site, and (iv) a primer binding site. The kit also comprises two or more SID decoders having light-generating labels. The components of the kit can be used for a plurality of materially different processes than the method of group I, including ligating the adapters to a pool of DNA fragments to allow subcloning of the fragments into vectors via the restriction sites, amplification of the fragments via the primer binding sites, or detection of the fragments via the sample ID sequence and associated decoders. Because these inventions are related for the reasons given above and the search required for Group I is not coextensive with the search required for Group III, restriction for examination purposes as indicated is proper.

3. Inventions II and III are independent and distinct. Inventions are independent and distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the kit of group II comprises a reference nucleic acid library and a plurality of probes that are derived from two different sources and that have appended to them a terminal sample ID sequence. The kit of group III comprises two or more adapters comprising (i) a protruding single strand, (ii) a sample ID sequence, (iii) a restriction site, and (iv) a primer

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binding site. The kit of group III also comprises two or more SID decoders having light-generating labels.

The library and probes of group II have a plurality of potential functions and effects including the identification of DNA binding proteins. The components of the kit of group III have functions and effects substantially different from those of group II, including ligating the adapters to a pool of DNA fragments to allow subcloning of the fragments into vectors via the restriction sites, amplification of the fragments via the primer binding sites, or detection of the fragments via the sample ID sequence and associated decoders. These substantially different functions and effects require substantially different modes of operation such as detection of protein binding for group II and the restriction, ligation, and amplification of nucleic acids for group III. Because these inventions have different modes of operation, different functions, and different effects, and because the search required for Group II is not coextensive with the search required for Group III, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


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6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R. Gunter whose telephone number is (703) 308-1701. The examiner can normally be reached on 9:00 - 5:00 M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-9212 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0198.

  
David R. Gunter, DVM, PhD  
December 10, 2002

  
B. J. JOHNSON  
PATENT EXAMINER